



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/033,576

11/09/2001

Robert J. Greenberg

S100-DIV3

8383

28284 7590 11/25/2009
SECOND SIGHT MEDICAL PRODUCTS, INC.
12744 SAN FERNANDO ROAD
BUILDING 3
SYLMAR, CA 91342

EXAMINER

OROPEZA, FRANCES P

ART UNIT

PAPER NUMBER

3766

NOTIFICATION DATE

DELIVERY MODE

11/25/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SCOTTD@2-SIGHT.COM
REVANS@2-SIGHT.COM

Office Action Summary	Application No. 10/033,576	Applicant(s) GREENBERG ET AL.	
	Examiner FRANCES P. OROPEZA	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/18/09 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 271,332-337 and 340 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 271,332-337 and 340 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

1. The Applicant amended independent claim 271 in the response filed 8/18/09, hence the rejection of record is withdrawn and a new rejection established in the subsequent paragraphs.

Claim Rejection – 35 USC 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 271, 332-337 and 340 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner is unable to find in the instant specification the limitation of claim 271 : "electrodes within a void have a common polarity". New matter may not be entered at this point in the prosecution. Appropriate correction is required.

Claim Rejections - 35 USC 103

4. Claims 271, 332 and 340 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,109,844 to de Juan, Jr. et al. ("de Juan") in view of U.S. Patent No. 6,083,251 to Shindo ("Shindo").

Art Unit: 3766

de Juan substantially discloses the instant invention, a device comprising an electrode array (micro-stimulator - figure 6 - 50) with insulation (figures 1, 3 - 35), voids and a plurality of electrodes (figure 3 - 24, 31) recessed and exposed in more than one dimension, the x and y planes, this configuration forming capacitors with the retina (figures 1, 3, 6; column 4, lines 25-27; column 5, lines 63-68).

As discussed in the previous paragraph of this action, de Juan discloses the claimed invention except the electrodes within the void having a common polarity.

Shindo teaches electrical stimulation using electrodes with a common polarity for the purpose of optimizing the patient's vision. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used electrodes within the void having a common polarity in the de Juan system in order use a stimulation configuration proven to recover eyesight (column 6, lines 5-15).

5. Claims 333-337 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,109,844 to de Juan, Jr. et al. ("de Juan") and U.S. Patent No. 6,083,251 to Shindo ("Shindo") in view of U.S. Patent No. 4,969,468 to Byers et al. ("Byers").

As discussed in paragraph 4 of this action, modified de Juan discloses the claimed invention except:

- the plurality of electrodes having different lengths (claim 333),
- the plurality of electrodes having a spike-shaped (claim 334),
- an integrated circuit (claim 335),
- the array body having a generally curved surface on at least one side (claim 336), and
- the electrodes being metal and at least partially coated in ceramic (claim 337).

Art Unit: 3766

Byers teaches electrode array configurations using a plurality of spike-shaped electrodes (Figure 6 - 12, 13; Figure 11 - 31, 32) being metal and at least partially coated in ceramic (Figure 7; column 6, lines 63-68), and having different lengths (Figure 11 - 31, 32), the electrode array body comprising an integrated circuit (Figure 6 - 7; column 10, lines 29-30; Figure 12 - 33-38; column 7, lines 63-66), and having a generally curved surface on at least one side (column 10, lines 17-20) for the purpose of having optimally designed metal electrodes whose spiked-shape, varying lengths, and ceramic coating allows the stimulation to be directed toward the targeted tissue in the retina for the purpose of creating a focus electrical stimulus, the electrode stimuli optimally controlled with proven control technology, an integrated circuit, and the array body having a generally curved-shaped body to conform to the retina to effectively and optimally contact and stimulate the retinal tissue. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a plurality of spike-shaped metal electrodes, at least partially coated in ceramic and having different lengths, and an electrode array body comprising an integrated circuit and having a generally curved surface on at least one side in the modified de Juan system in order to customize the stimulation device for the specific patient needs so stimulation of the retina tissue in that specific location enables the patient to gain an optimal degree of sight while not penetrating the retinal basement membrane at the surface of the retina, hence avoiding mechanical damage to the cells of the retina and the ganglion cells at the surface thereof (column 1, line 67 - column 2, line 2; column 2, lines 10-13).

Specification

6. The amendment filed 8/18/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 271 - "electrodes within a void have a common polarity". Applicant is required to cancel the new matter in the reply to this Office Action,

Statutory Basis

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 5 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3766

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl. H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM-5 PM EST; Tuesday, Thursday 9AM-3PM and 9PM- 11 PM EST. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/
Patent Examiner, Art Unit 3766
November 21, 2009

/Carl H. Layno/
Supervisory Patent Examiner, Art Unit 3766